

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BENJAMIN J. KWITEK

Appeal No. 2001-2224
Application 09/173,445

ON BRIEF

MAILED

NOV 29 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 3, 7 to 10, 14 and 21 to 29, all the claims remaining in the application.

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Appellant's invention concerns a grip for golf clubs and other sports implements. Claim 21 is illustrative of the subject matter in issue, and reads:

21. A grip adapted for attachment to an implement including a handle, comprising:

a longitudinally extending tubular shell including an inner surface shaped and dimensioned for attachment to the handle of the implement and an outer surface; and

a viscoelastic hand surface having a thickness secured about the outer surface of the tubular shell, wherein the viscoelastic hand surface is a viscous liquid material contained within an elastomeric bag; and wherein the tubular shell includes a first end and a second end, and the tubular shell includes an outwardly extending first lip adjacent the first end of the tubular shell and a outwardly extending second lip adjacent the second end to the tubular shell, the first and second lips being shaped and dimensioned to retain the viscoelastic hand surface in position on the tubular shell.

A copy of the claims on appeal is contained in the appendix of appellant's brief.¹

The references applied in the final rejection are:

Minami	5,322,290	Jun. 21, 1994
Moore, III et al. (Moore)	5,555,584	Sep. 17, 1996
Huang	5,730,669	Mar. 24, 1998

¹ The examiner notes that the copy of claim 14 is incorrect.

Claims 1, 3, 7 to 10, 14 and 21 to 29 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Minami in view of Huang and Moore.²

We will first consider the rejection in relation to claim 21. Insofar as it concerns the structure recited in claim 21, the examiner states the basis of the rejection as follows (answer, pages 4 and 5):

Minami discloses a tubular shell (5), a viscoelastic hand surface about the outer surface of the tubular shell having a thickness, a central section (Ref. no. 6, Col. 3 Lns. 2-4, Col. 3 Lns. 14-16, Fig. 3), a tubular shall [sic: shell] being a soft elastomer in form of being made of rubber and being softer than the hand surface (Col. 3 Lns. 51-53), a golf club grip (Fig. 1), and a shell being substantially cylindrical shaped with a slight taper (Figs. 2-3). . . .

Minami lacks a viscoelastic hand surface being a viscous silicone gel contained within an elastomeric bag and a tubular shell having circumferential lips to contain the viscoelastic hand surface . . . Huang discloses a shell having circumferential lips and a central section having a depth as defined by the first and second lips which is substantially the same as the thickness of a viscoelastic hand surface (Figs. 11 and 13). In view of the patent of Huang it would have been obvious to modify the grip of Minami to have lips on a tubular shell as defined by the claims in order to better secure a hand surface about a tubular shell . . .

²A rejection of claim 7 under 35 U.S.C. § 112, second paragraph, is not repeated in the examiner's answer, and therefore is deemed to be withdrawn. Ex parte Emm, 118 USPQ 180 (Bd. Apps. 1957).

Moore discloses a viscoelastic hand surface being a viscous silicone gel (Col. 5 Lns. 32-67) material contained within an elastomeric bag for a tennis racket in order to produce a more comfortable to wear grip and to distribute the weight and pressure more evenly to a hand of a player (Col. 1, Lns. 19-27) and sheets of gel material of about 1/8 to 1/4 inch (Col. 10, Lns. 55-64). In view of the patent of Moore it would have been obvious to modify the grip of Minami to have a viscoelastic hand surface as defined by the claims in order to produce a more comfortable to wear grip and to distribute the weight and pressure more evenly to a hand of a player.

Although appellant's brief contains general statements to the effect that it would not have been obvious to combine Minami, Huang and Moore (e.g., page 7, lines 1, 2 and 16 to 18; page 9, lines 1 to 3; page 10, first paragraph), appellant does not present any specific reasons as to why it would not have been obvious to combine Minami and Moore as proposed by the examiner, supra, i.e., as to why it would not have been obvious to employ the viscous gel within a bag disclosed by Moore as the outer layer 6 of the grip of Minami. Rather, appellant's specific arguments are directed toward whether it would have been obvious, in view of Huang, to provide the thus-modified grip of Minami with first and second lips as recited in the claim.

Huang discloses a grip for the handle of a device such as a golf club, in which a strip S having a felt inner layer 22 and a polyurethane outer layer 26 is wrapped around a sleeve 60 (Fig.

11 to 14), after which the sleeve can be installed on a golf club (col. 6, lines 35 to 38). At each end of the area around which the strip S is wrapped are lips in the form of a shoulder on a cap 62 at the top of the sleeve 60, and shoulder on a guide cylinder 64 at the bottom of the sleeve. Appellant contends that to provide such lips on the grip of Minami would not have been obvious because there is no suggestion of "the necessity of providing lips for maintaining a high viscosity outer surface member upon an inner shell" (brief, page 8), and "Huang makes no provision for utilizing upper and lower lips as a mechanism for retaining viscoelastic material therebetween" (brief, page 10).

In the specification of the Huang patent, there is no express disclosure of any particular purpose for lips 62 and 64. However, there is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention, but rather, the suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art. Motorola Inc. v. Interdigital Technology Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997). The obviousness issue must be looked at "through the eyes of one of ordinary skill in the art and what one would be presumed to know with that background." Id. In the present

case, one of ordinary skill considering Huang's disclosure concerning Figs. 11 to 14 would have known that lips 62, 64 served at least two purposes: (1) they define the area around which the grip material S is to be placed, and (2) they help to retain the grip material S in position on sleeve (shell) 60, in that they would prevent it from being moved up or down on the shell (as shown in the drawings). In view of this knowledge which one of ordinary skill would have derived from Huang, we consider that it would have been obvious to one of ordinary skill, in modifying the grip of Minami by utilizing a viscous liquid in an elastomeric bag, as taught by Moore, as the outer layer 6 of Minami, to utilize this knowledge by providing Minami's inner layer (shell) 5 with lips at each end of the bag in order to serve the purposes which lips 62, 64 of Huang self-evidently serve, namely, (1) to define the area of the grip where the bag is to be placed, and (2) to help to prevent the bag from moving out of position, particularly where gripped by the user. The suggestion to provide such a positive means for locating and retaining the bag would have come not only from Huang, as discussed above, but also from the nature of the grip of Moore. Thus, not only does Moore teach that the bag (gel pad) should be attached to the handle by various means, including adhesive, or

that the bag may be made "permanently integral" with the handle (col. 4, lines 62 to 67), but also it would have been evident that in order for Moore's grip to be effective in its intended purpose of providing a custom fit for the individual user's hand it would have to be located and retained in the same position on the handle of the tennis racket or golf club at all times. In this regard, we disagree with appellant's argument at pages 8 and 9 of the brief that none of the references provide teachings which are relevant to the other references.

Accordingly, the rejection of claim 21, together with claims 22 to 27 which appellant has grouped therewith (brief, page 5), will be sustained.

Claim 1 is similar to claim 21, but includes the limitation that the first and second lips define a central section within which the viscoelastic hand surface is positioned, "wherein the central section has a depth as defined by the first and second lips which is substantially the same as the thickness of the viscoelastic hand surface."³ We agree with the examiner that, in modifying Minami in view of Moore and Huang, it would have been obvious to provide lips which meet this limitation in view of

³The quoted language does not appear to have antecedent basis in the specification, as required by 37 CFR 1.75(d)(1).

Huang's showing in Fig. 13 that lips 62, 64 are approximately the same depth as the hand surface S. As the examiner states at pages 4 to 5 of the answer, it would have been obvious in view of Huang "to make the grip visually pleasing to a user by having the outer diameter the same size between the tubular shell [i.e., the lips] and the viscoelastic hand surface." In our view, this would have been readily suggested by Huang.

We therefore will sustain the rejection of claims 1, 3, 7 to 10 and 14, claims 3, 7 to 10 and 14 having been grouped with claim 1 (brief, page 5).

Claims 28 and 29 each recite that the viscoelastic hand surface has a thickness between approximately $1/16$ " and $1/4$ ". Appellant argues on page 11 of the brief that "[n]othing in the prior art suggests the claimed range for the viscoelastic hand surface", but as the examiner points out at page 5 of the answer, Moore disclose at col. 10, lines 55 to 64, that the gel material can be rolled into sheets $1/8$ to $1/4$ inch thick and sealed into an envelope. Consequently, we conclude that it would have been obvious to make the viscoelastic hand surface of the Minami grip, as modified by Huang and Moore, $1/8$ to $1/4$ inch thick, which is within the range recited in claims 28 and 29.

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The rejection of claims 28 and 29 therefore will be
sustained.

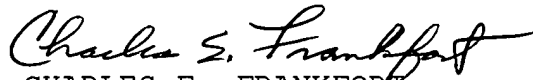
Conclusion

The examiner's decision to reject claims 1, 3, 7 to 10, 14
and 21 to 29 is affirmed.

AFFIRMED



NEAL E. ABRAMS
Administrative Patent Judge



CHARLES E. FRANKFORT
Administrative Patent Judge



LAWRENCE J. STAAB
Administrative Patent Judge

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